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CHARLES ELMORE DROFFLEY

IN THE

Supreme Court of the United States

October Term, 1944.

No. 469.

SPECIAL EQUIPMENT COMPANY,

Petitioner,

vs.

CONWAY P. COE, Commissioner of Patents,

-Respondent.

REPLY BRIEF FOR PETITIONER.

CLARENCE J. LOFTUS,
JAMES BALLARD MOORE,
CURTIS F. PRANGLEY,
JAMES M. GRAVES,
Counsel for Petitioner.

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STATEMENT.

The respondent's brief is quite confusing.

It bases its principal argument, on an assumed factual foundation, unsupported by and contrary to, the record in this case.

It sets up a "straw man," which it attempts to demolish by arguments, and a mass of decisions which have nothing to do with the real issues in this case.

We refer this court to our main brief for a correct exposition of the facts and law applicable to the issues

in this case, as *disclosed by the record*. Nothing has been developed, in the department's brief, which requires any change in our main brief.

We reply to certain points with the thought of keeping the record and issues straight and dissipating the confusion. We like to confine the presentation to the record.

Point I.

Ewald's main or primary invention is adapted for operating on whole or *pre-split* pears. If on whole pears, a splitting knife is needed; *if on pre-split pears, the knife may be left in, or omitted entirely, as it would be a useless appendage when running on pre-split pears.*

The claims found allowable, which the department refers to as claims on the *entire* machine, are limited to a combination which *specifically includes* the knife and therefore, would not protect Ewald's main or generic invention, *minus* the knife, when running on pre-split pears.

Point II.

First, we will endeavor to demonstrate the meaning of "*subcombination claim*," in law.

Assuming an application for a patent on a machine presents a claim comprising, in combination, the elements A, B, C, D, and E; also a claim on a combination comprising *only* the elements A, B, C, and D; another comprising *only* the elements A, B, and C; and still another comprising *only* the elements or features A and B. The latter three are *subcombinations* of the first; the third is a *subcombination* of the second; and the fourth, a *subcombination* of the third.

Now, if machines are manufactured and sold commercially, utilizing the elements or features A, B, C, D and E, then *necessarily* the structures of each of the *subcombination* claims have been put to commercial use, and there cannot possibly be any charge or contention of suppression, because obviously each of the features and elements of each *subcombination* claim is incorporated and used in such machine.

In such case, the *main* or *primary* invention would be covered by the *subcombination* claims, whereas the claim calling for A, B, C, D and E, in combination, would be the limited or narrow claim concerning the *secondary* invention. That is the sense in which we have used the term "main, primary, generic, or basic invention" throughout this case, and the term "*subcombination*," which is in strict accord with the uniform decisions of this and other courts.

The department's brief says again and again, contrary to the clearly established facts, that petitioner *suppressed*, and intends to *suppress*, the use of the structure covered by the *subcombination* claims here sought, and then uses that disproven premise as the *sole* basis for its *principal* argument. We said before, and say again, that the use of the structure covered by the *subcombination* claims *was not suppressed*. There is not one thing in the entire record which could possibly form the basis for such a statement. The record *unquestionably shows*, and the appellate court found, that the structures of the *subcombination* claims here sought were incorporated and used extensively in the machines made and sold by Ewald's company. Therefore, any statement that the features and elements called for by the *subcombination* claims were suppressed is not true.

The brief says that the subcombination claims were sought to protect the *entire* machine, or the patent monopoly of the complete machine. This does not exist, in fact.

The department asserts that a patent has been allowed, which covers the *entire* machine. No patent has yet issued on this application. Combination claims have been found allowable *which include the splitting knife* and may be correctly designated the *splitting knife claims*, for so far as those claims are concerned, any one could make and use Ewald's machine, by merely leaving out the knife, and running on pre-split fruit. Ewald is not seeking a duplicate of that claim, but claims on *subcombinations* of elements and features which do not include the splitting knife.

The claims in issue are sought to cover Ewald's main or primary invention, which comprises, in combination, his novel elements and features, whether used on whole or pre-split pears. "Doubtless a patentee is entitled to every use of which his invention is susceptible, whether such use be known or unknown to him." (*Potts v. Creager*, 155 U. S. 597, 606.)

If the Ewald machine or mechanism for bobbing, peeling and coring pears was all old, and the *only* contribution that Ewald made was to *place in that old machine a splitting knife*, then there would be some reason for contending that his combination claims should be limited to the inclusion of the splitting knife, but that is far from the situation. The Ewald machine for bobbing, peeling and coring pears, minus the knife, was *basically* and *broadly new with Ewald*. As said by the Board of Appeals, there is no prior art relied upon. No prior art was cited in the answer in the present litigation. None is urged here.

A claim which includes the splitting knife would afford no protection whatever on Ewald's combination for bobbing, peeling and coring pears, minus the knife. In other words, so far as such a claim is concerned, Eward would then only be credited with being the inventor of placing a splitting knife in an old machine. This must be so, because if the knife is removed, the claim would be of no avail in affording any protection whatever on the real machine, that is, his machine minus the knife. Certainly Ewald has done far more in the way of invention than merely conceiving the idea of putting a splitting knife in an old machine. Therefore he is, in law, entitled to claims commensurate with his important contribution to the art.

It doesn't make any material difference whether Ewald said in his original application that his device operated on pre-split pears with the knife removed, because the record, clearly established the fact that the very combination illustrated and described in his application can and was so operated successfully. Ewald is entitled to this advantage and use, even though he didn't know it and was entirely ignorant of the fact. (See our main brief, pp. 15 and 27.) If Ewald illustrated and described, as he did, a machine in which that operation or use is inherent, then, under the law, he amply disclosed such a machine, and he is clearly entitled to a subcombination claim which would protect his machine when so operated. Having made this revolutionary invention and every novel part, feature and element thereof, he should not be dismissed by a holding which, in effect, says: All you have done, Mr. Ewald, is to put a splitting knife in an old machine, and, therefore, your claim must be limited to a splitting knife in the machine.

Assuming applicant and his assignee have intentionally and deliberately suppressed the exploitation and use, and

intends to suppress the exploitation and use, of a combination covered by one of the claims of his patent, which they have not, and do not intend so to do, that, obviously, under the law, would be no grounds for denying the claims in issue, or holding them invalid, as pointed out in our main brief (p. 22 *et seq.*).

Moreover, since filing our main brief, this Court, in the *Hartford* case, on January 8, 1945, 64 U.S.P.Q. 18, reaffirmed the rule announced in the *Paper Bag* case. Mr. Justice Roberts, speaking for the Court, said, at pages 38 and 39:

“A patent owner is not in the position of a quasi-trustee for the public or under any obligation to see that the public acquires the free right to use the invention. He has no obligation either to use it or to grant its use to others. If he discloses the invention in his application so that it will come into the public domain at the end of the 17-year period of exclusive right he has fulfilled the only obligation imposed by the statute. This has been settled doctrine since at least 1896. Congress has repeatedly been asked, and has refused, to change the statutory policy by imposing a forfeiture or by a provision for compulsory licensing if the patent is not used within a specified time.”

It is interesting to note that the Anti-Trust Division, in its printed brief filed in the *Hartford* case, attempted, without success, (p. 211, *et seq.*) to dispose of this Court's decision in the *Paper Bag* case, and press upon it, as the correct law, the decision of the Court of Appeals in the instant case.

Point III.

It is evident, we think, that the department's brief, as well as the Court of Appeals, erroneously, used the term “main invention” synonymously with the Ewald ma-

chine plus the splitting knife, as though the main invention disclosed resided in and was based on the splitting knife, which obviously it is not. It did not use the term "main invention" as meaning the primary, basic or generic invention, illustrated and described in Ewald's patent application, which forms the *heart* and works of the commercial machine.

The Ewald drawings and specification set forth a broadly new and novel machine for bobbing, peeling, and coring fruit, which was, and can be, operated on either whole or pre-split fruit (pears). When operated on pre-split fruit, the splitting knife may be and was *entirely* removed. When so operated, it "represented a tremendous advance" (R. 148) over the prior art.

Ewald's counsel said in ~~the~~ Appellate Court, (R. 155) "The claims in issue are sought purely to prevent appropriation of the Ewald machine by the obvious expedient of eliminating the splitting mechanism." That is a far cry from saying that petitioner has suppressed or intends to suppress the combination covered by the claims here sought, which do, in fact, cover Ewald's main or primary invention, or that the claims are sought to protect the so-called complete machine, which includes the splitting knife.

The purpose in seeking these claims, which is a bona fide and lawful one, and one recognized by all the courts since the inception of our patent system, is to protect and cover by a proper claim Ewald's primary, basic, or generic invention.

Point IV.

The anti-trust cases and the anti-patent contentions with which the department's brief is loaded have been presented skillfully and adroitly, but this anti-trust or "anti-patent" crusade simply does not apply to the present case or any of the issues thereof.

Neither Ewald nor his company had anything whatever to do with the activities of the strangers whose acts, in violation of the anti-trust laws, have been so fully discussed in the department's brief. Not a single thing which the courts condemned in any of those cases exist in the present record. Indeed, the particular things which that brief and the Court of Appeals attribute to Ewald or his company *do not exist in this record.*

Point V.

The government's brief, on page 3, says:

"The application as filed contained claims covering the entire machine, and also a claim which covered all the features of the machine except the splitting knife. The latter claim was rejected by the Examiner and the Board of Appeals in the Patent Office as being 'incomplete, misleading and broader than the invention' because it implied that the mechanism can peel whole pears, whereas the application disclosed a mechanism for peeling and coring half pears but not whole pears."

The brief then goes on to say, in a footnote, that Ewald took no steps to review that decision of the Board of Appeals.

Unless the Court's attention is directed to the facts, the above quoted statement could be quite confusing. The facts are these. The claim involved on the first appeal to the Board was not contained in Ewald's application as filed. It was *Claim 32* and *only Claim 32*, presented June 22, 1936. That claim, at the outset, definitely specified means for receiving "*whole pears*", and then the claim *subsequently included the paring and coring means*. The paring and coring means, which are carried by the second turn table or turret, *can only operate* on half sections of

fruit. The Board rejected that claim because the claim at the outset specified "*whole pears*," whereas the things which later do the paring and coring could only work on *half pears*; and, therefore, the claim thus implied that the coring and peeling mechanism *itself* would peel and core *whole pears*, which it would not. Under those circumstances, the Board said, with reference to this Claim 32 (R. 132):

"It is to be noted that the claim includes a fruit turret having receiving and holding means for receiving *one at a time whole pears*. The rest of the claim does not mention that there is any means for halving the pears. Hence it would be inferred from the claim that the mechanism subsequently included is of a nature so as to pare the whole pears. But applicant has disclosed no such means. He has disclosed a specific mechanism for paring and coring half pears, and it is not evident how any mechanism can be provided for paring and coring whole pears. We believe that the examiner's rejection is sound."

In view of the fact that Claim 32 was so interpreted by the Board, and the fact that the peeling and coring mechanism, carried by the second turret, will only operate on half sections, Ewald concluded not to pursue the appeal further, but instead presented in his renewal application, as he had a perfect right to do, the new claims here involved, viz., 38, 39, 41 and 44. None of these claims, specifically, or by *implication*, calls for feeding "*whole pears*."

Moreover, under Section 4897, Ewald had the right to present these claims "the same as in the case of an original application". Therefore, there can be no unfavorable inference because it did not pursue the first appeal involving Claim 32.

The objection to former Claim 32, and the ground on which it was rejected by the Board, are absent in the claims in issue. This will be readily seen from a comparison of rejected Claim 32 with any one of the four claims

here involved, take, for example, Claim 44. We have, for convenience, set out below, in one column, Claim 32, rejected on the first appeal; and in another Claim 44, here involved.

32. An automatic machine for preparing pears comprising a fruit turret having a plurality of pear receiving and holding means for receiving one at a time *whole* pears, and bobbing means operable in succession upon the pears in said holding means, transfer mechanism co-operable with said turret for receiving each pear from the turret with its stem end bobbed, a second turret including additional spaced receiving and holding means adapted to receive the pears from the transfer mechanism, means for moving said additional turret and its receiving and holding means in synchronism with said first mentioned turret and its holding means and transfer means and paring and coring mechanism mounted in the path of movement of said additional holding means and mechanism for actuating said turrets, said transfer mechanism, and said paring and coring mechanism in synchronism.

44. In a fruit preparation machine, first and second rotary turrets, each provided with a plurality of spaced fruit holding members, means for intermittently operating said turrets in synchronism to a plurality of stations, the first turret at one of its stations receiving fruit on its fruit holding member at said station, bobbing means operable upon the fruit when the first turret is at a second station, means operable upon the fruit when the first turret is at a third station and the second turret is at one of its stations for transferring the fruit from the fruit holding members of the first turret to the fruit holding members of the second turret, and mechanisms at subsequent stations of said second turret for paring and coring the fruit, and means for actuating said transferring means and said paring and coring mechanisms in timed relation to the movements of said turrets.

The Board, apparently, however, after the original application was renewed in the second appeal, involving the four claims here in issue, confused them with former Claim 32, involved in the first appeal, and entirely overlooked this point of difference.

The Board, on the second appeal, said "No anticipatory art is relied upon" (R. 133), but concluded:

"Without a doubt subcombination claims may be obtained in addition to claims to the entire combination. Such subcombination claims should cover a construction which will accomplish a useful result. In the present case there is no indication that the construction claimed can or was ever intended to accomplish a result. To accomplish any result it is necessary to employ a pear-splitting means." (R. 135)

As a matter of law, a subcombination need not be useful in or of *itself*. (See our main brief, p. 25.)

It will be noted that the Board, in concluding against the claims in issue in the second appeal, said:

"There is no indication that the construction claimed can or was ever intended to accomplish a result."

The Board did not have before it the testimony in this case, or the motion pictures which were before the Court of Appeals, and from which that court found that the Ewald machine without the knife was successfully operated when fed with pre-split pears and was a tremendous advance over the prior art (R. 148).

In fact, the Board had no evidence whatever before it as to the successful operation of the Ewald machine, with or without the knife.

The Board further overlooked the fact that the claims in question, as a matter of fact, were made and *presented*

by Ewald himself, which shows that he did actually contemplate running his machine on pre-split pears, and also overlooked the fact that Ewald's claim No. 1, which he first presented when he filed his original application on October 6, 1932 (R. 80), actually *disclosed* and *covered* a machine without a splitting knife, which, in view of the evidence in this case, could be and was operated successfully when running on pre-split pears. In addition to all this, the Court of Appeals clearly rejected the Examiner's ruling, the Board's ruling, and the findings prepared and filed by counsel for the Government in the District Court, when it said (R. 148):

"In the present case we have typical subcombination claims. There is no lack of completeness or clarity in them; they specifically point out what is claimed as an invention and it would not be difficult to construct the subcombination from the drawings. The notion that the bobbing operation cannot take place after the pear has been split by hand ignores the texture and character of canning pears. The suggestion that the subcombination is inoperative when the pear is pre-split by hand is directly contrary to the evidence, particularly to the incontrovertible evidence of the motion picture which was displayed to this court as well as to the trial court. The notion that the inventor must have thought only in terms of splitting as an intermediate process, ignores the long history of pear canning as a hand process, and the inescapable fact that one who was experimenting in this area must have tried a variety of arrangements until he found the one most adapted to his purpose. Considered in terms of the older practices in pear canning the subcombination machine, standing alone, represented a tremendous advance, and, in operation, would result in great saving of manpower, of time, of working space, and of the more primitive equipment formerly used. The record makes these facts apparent beyond question."

Point VI.

THE DISTRICT COURT'S FINDINGS.

The department (p. 38) refers to the District Court's findings, and urges that they are not to be set aside unless shown to be clearly wrong, citing Rule 52 (a) F.R.C.P., and *Admanson v. Gilliland, etc.* We say the rule does not apply here for several reasons.

1. The District Court's findings are clearly *contrary* to the evidence and the motion picture exhibit. The Court of Appeals, after stating its findings and conclusion, (R. 14) which obviously reject the findings filed in the District Court, said: "The record makes these facts apparent beyond question" (R. 148).

2. The findings of the District Court are not findings as contemplated by Rule 52(a), which provides that the District Court "shall find the facts specially and state separately its conclusions of law". That the District Court did not do here, but after the trial, without giving any oral or written opinion, it simply entered a memo, consisting of three words, "Judgment for defendant" (R. 9).

About a *month later* the government attorneys prepared and submitted findings of fact, which the District Court filed *as submitted*. These findings were not drawn or prepared by the District Court, but by counsel. The findings signed by the District Court stated, among other things, that the subcombination claims themselves did not "combine to produce *any useful result*." It is difficult, indeed, to conceive how it could have signed such a findings, when the testimony of the single witness in the case, Skog, and the motion pictures, show that the subcombination machine standing *alone* and operated without the splitting knife, operated successfully, and as found and held by the Ap-

pellate Court, represented a tremendous advance, and in operation would result in great saving of manpower and of time, which facts the Court of Appeals said were made apparent beyond question.

3. The construction and operation of the machine and the manner in which it can be operated on *pre-split pears* is shown by both oral and *documentary* evidence. Therefore, the situation is not to be confounded with one where a fact turns wholly or primarily on the *oral* testimony of witnesses in open court. In such instances the rule is to the effect that a *proper* finding, *actually made by the trial court*, where it has an opportunity to hear and see the witness, is entitled to great weight. But the books are also full of decisions to the effect that where a finding is entirely unsupported, or where it is obviously *contrary* to the proven facts, or where it turns largely on documentary evidence, this rule does not obtain, particularly where the District Court's finding is really a finding of counsel. *Process Engineers, Inc. v. Container Corp.*, 70 F. (2d) 487, at 489.

Further, the Court of Appeals disapproved and rejected the findings, so far as they may be termed findings, by the Board of Appeals and the District Court.

Point VII.

Coming now to the department's third point, as to whether in any event the subcombination claim should be rejected as not properly within the scope of the renewal application, we say that the point is clearly without merit or foundation in fact or law, and is not open here.

It is true that Ewald renewed his application under Section 4897 of the Revised Statutes, as he then had a perfect right to do.

This statute was intended to take care of a situation where the government *final* fee had not been paid within six months from the date of the notice of allowance.

Ewald's renewal simply consisted (R. 125) of a short statement identifying the *original* application, with a request that the application be renewed and that "the *original specification, oath and drawings* may be used as part of" the renewed application.

The abrogated Statute 4897 provided that "the applicant * * * shall have a right to make an application for a patent for such invention or discovery *the same as in the case of an original application*". The only limitation is as to the time it must be done; first, within two years and later, by amendment, within one year from the time of the allowance.

Patent Office Rule 175, no longer in force, meant simply this: that the drawings and specification of the renewal should illustrate and describe the same invention as the original filing. The practice uniformly established throughout the existence of that statute, permitted *adding of new and additional claims*, so long as such claims were based on the subject matter illustrated in the drawings and set forth in the specification of the original application.

In the present case there can be no doubt that the renewal is for the same invention because the *identical drawings* and the *identical oath* and the *identical specification* were used. The meaning of the statute and the rule is simply that the matter disclosed in the drawings and in the specification must be the same. This must be so, because the statute itself says that the applicant shall have the right to make such renewal application *the same as in the case of an original application*. In an original applica-

tion there is no question that applicant can make claims on every patentably novel feature disclosed by his drawings and specification.

There is no admission by Ewald whatever, as stated by the department in its brief, that his renewed application must be limited to the claims theretofore found allowable. All that Ewald said in asking for the renewal of his application, which, after all, is merely a *reinstatement*, was that the original specification, oath and drawings be used. This saved him the expense of preparing and filing a new set of papers and drawings. That was common practice, and has been for over fifty years. With the renewal, Ewald concurrently filed an amendment presenting the claims here in issue.

In re Kaisling, 44 F. (2d) 863, does not, in fact, support the contention that new claims cannot be added by renewal. In that case (p. 864), the applicant did not rest on the original application papers as they stood, but presented an amendment with his renewal petition directing a change in the statement of the invention so as to cover the system and directing a substitution for the lock claims, which were the only ones theretofore allowed, of claims for the *system* as disclosed by the *modified* specification.

That the Court of Customs and Patent Appeals in *In re Kaisling* did not so hold, is made clear by the same court, about five years later, with the same personnel. The latter case is *Doherty v. Dubbs*, 68 F. (2d) 373. Associate Judge Garrett, who wrote the opinion in both cases, in speaking for the court in the *Dubbs* case, after discussing at some length *In re Kaisling*, said (p. 375):

“The opinion contains expressions which, considered abstractly and apart from the facts and issues there dealt with, might lead to the conclusion that this

court went further than there was any intention of going and attempted to lay down new principles of patent law or practice.

"It would seem that learned counsel for appellant have so construed that opinion in their presentation of the instant case.

"Such construction is erroneous and the opinion there rendered should be considered as a precedent only as to issues which are analogous to the issues there dealt with and decided."

Continuing, the court said (p. 375):

"Here Dubbs apparently seeks only to add to the claims which stood allowed additional claims which he alleges are supported by his original disclosure."

This is exactly the situation in the Ewald case. Ewald simply seeks to add to claims which stood allowed, additional claims which are clearly supported by the disclosure of the original drawings and specification. Ewald has not amended his drawing or specification in any manner, shape or form. Further, the court said (p. 375):

"The *Kaisling* case, *supra*, is not an authority for holding Dubbs not entitled to make the claims which constitute the counts here involved."

To the same effect see *Murray v. Bailey*, 112 F. (2d) 1015 (C.C.P.A.), at page 1016.

Fifty years ago, the proposition that new claims could not be added in a renewal application was strenuously urged before Circuit Judge, later Mr. Justice McKenna, in *Bowers v. San Francisco Bridge Co.*, 69 Fed. 640. The court there, after reviewing Section 4897 and the authorities applicable, overruled defendant's contention, and held that in a renewal application new and additional claims could be added, and that under the statute the renewal application was not limited to what was allowed in the first, but may embrace the whole invention if it be greater than that allowed.

We say that is the situation in the instant case. The claims found allowable, which included a splitting knife, was much less, and more limited than Ewald's primary, main, generic or basic invention, in that his primary invention is much greater than *merely including a splitting knife in an old machine*. As no new matter was added either to the drawings or specification, and as the elements and features specified in the subcombination are clearly illustrated in the drawings and described in the specification, applicant is entitled to make and add the subcombination claims here in question. The Patent Office has so held, and necessarily so, by accepting and filing the claims and considering them on *their merits*. The Commissioner of Patents' action in so doing automatically ruled that they are proper under the renewal statute and that they related to the same invention described in the original application. This action is of the kind and character which this court has said is not *re-examinable* in any other tribunal, at least unless the action of the Commissioner is impeached on account of gross fraud or connivance between him and the applicant. No such charge can be made here. See: *Allen v. Blum*, 3 Storey 740, 744 (Justice Storey); *Topliff v. Topliff*, 145 U. S. 156, at 171; *Stimpson v. Westchester Railroad Co.*, 4 How. 380; *Battin v. Taggart*, 17 How. 74; *Rubber Company v. Goodyear*, 9 Wall. 788; *Seymour v. Osborne*, 11 Wall. 516; *Brown v. Guild*, 23 Wall. 181; *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486; *Marsh v. Seymour*, 97 U. S. 348; *Eames v. Andrews*, 122 U. S. 40.

With regard to renewals, Patent Office Rule 176 provides that:

"In a renewal the oath, petition, specification, drawing, and a model of the original application may be used; but a new fee will be required. The renewal application will not be regarded for all purposes as a

continuation of the original one, but must bear date from the time of renewal and be subject to examination like an original application."

It is thus clear from this rule that the renewed application is treated the same as an original application and is "subject to examination like an original application."

Point VIII.

Our adversary's brief, on page 8, says the court found there is no intention to use or license others to use the partial machine, and that there is no reason for so doing when there is available the complete machine, which does the cutting mechanically. Throughout this litigation and until after the Court of Appeals' decision, there was never *any reason*, for making a statement as to what Ewald's intentions were, as to granting licenses under the subcombination claims. The point was never urged by either party and never referred to until it was first mentioned in the Court of Appeals' opinion. Therefore, in the petition for rehearing, it is stated (R. 156) that it is definitely the inventor's intention, and was from the outset, and that it is his future intention to make, or grant licenses to make, the subcombination whenever and wherever deemed advisable.

We challenge the department to find one scintilla of evidence which in any manner, shape or form supports its conclusion. The only support is the figments of an apparently wishful imagination. On the contrary, Skog testified that if they were not allowed to use the splitting knife in the machine (R. 25), the Ewald machine could be very practically operated commercially by pre-splitting. The evidence shows this beyond question, and the court so found. Further, there is not the slightest intimation throughout the entire record or in any of the briefs or

statements of counsel for petitioner that it would not grant a license under the subcombination claim. The petition for rehearing (R. 156) definitely states:

“Appellant has the right and reserves the right to use or license others so to do, when he so desires, his important invention for bobbing, peeling and coring pears either when the pears are pre-split by hand or split in the machine. It was definitely the inventor's intention so to do from the outset, as shown by the undisputed evidence in this record.”

Point IX.

On page 10 of the department's brief, it quotes a partial statement made by counsel for Ewald, at page 17, in its brief filed in the Court of Appeals. The sentence, partially quoted, was used in the following paragraph of that brief (pp. 16-17):

“Art. 1, Sec. 8 of the Constitution (Appellant's App. 140) limits the grant of patents under Congressional legislation to those which promote progress of science and useful arts, and the Supreme Court has, in accordance with the constitutional provision, held that, when the claim of a patent is so inordinately broad that the monopoly accorded by the patent would retard, rather than promote, progress of an entire art or field of science, that claim is invalid. *O'Reilly v. Morse*, 15 How. 62, 56 U. S. 601, 623. It is self-evident, and the Patent Office has not raised any claim to the contrary, that the claims in issue do not seek, nor are they capable of covering an entire art or field of science. The claims in issue are sought purely to prevent appropriation of the Ewald machine by the obvious expedient of eliminating the splitting mechanism.”

In order to understand that paragraph, we should keep in mind that in *O'Reilly v. Morse*, the court was dealing with a claim which is construed to broadly cover a *result*,

Therefore, Ewald's counsel was attempting to point out that he was not seeking any such claim here, but purely claims which would cover the Ewald primary invention, so that it could not be used with impunity by a competitor, by merely eliminating the splitting knife from the machine.

Point X.

Respondent's brief, page 13, after apparently contending that the statute requires a patentee to manufacture, sell, use, or permit others so to do, says: "Use was the dominant thought", citing in the footnote, the *Gayler v. Wilder* and the *Marconi Wireless* cases.

Both those cases had to do with a contest as to *originality*, that is, who was the first inventor. In such matters, it is clearly established that the principal things determinative of such issue are *conception*, *disclosure* and *reduction to practice*. Actual reduction to practice means building and actually operating the thing embodying the invention. It is uniformly established in the Patent Office and in this and other courts, without exception, that the filing of a proper application in the Patent Office constitutes a *constructive* reduction to practice, and, therefore, in law, so far as determining the question of originality between two contestants, is even more effective than actually building and using the thing embodying the invention. That point and the cases cited have nothing whatever to do with this case. There is no question of originality here.

Point XI.

Respondent's brief, on page 10, says that the Ewald machine was run on pre-split pears, without the knife, at the suggestion of petitioner's attorney, evidently attempting to make some point of this. As a matter of fact, Skog on

cross-examination (R. 23) was asked: "When did you first try out this machine with pre-split pears?" and he answered, "So far as that question is concerned, the original machine that Mr. Ewald started to devise was started that way." Then later, when he was asked at whose suggestion the particular operation was had when the moving pictures, introduced in this case, were taken, he said, at the top of page 24: "It was done at our attorney's suggestion." Petitioner's attorneys, when they filed this suit on May 21, 1941, full well realized that it would be well to prove by *proper evidence*, rather than leaving the point to argument or speculative expert opinion, that the subcombination claims without the knife were for a useful, complete, operative machine. In order to make such proof, the only proper way would be to suggest or instruct Ewald's company to run the machine on pre-split pears, minus the knife, and not only have someone witness the operation, who would be qualified to testify, but also to have motion pictures taken of the operation to establish the facts, which they did. It is common practice, approved by all courts, for counsel to instruct his client, in advance of the trial, to make demonstrations and operations, etc., so that proper proof can be offered at the trial, rather than leave the point to argument and speculative opinion.

Point XII.

On page 42 of its brief, the respondent says the claims in question fail to disclose the means by which the coring and peeling device can be made to operate upon pears, that is, by pre-splitting. This statement is very confusing. It is difficult to believe it was intended, because the drawings and description specifically show and describe a coring and peeling means in the second turret which work and *can only work* on pears already split, that is, the pears are split before they even reach either the peeling or coring means.

That is fully disclosed and made clear beyond question in the application. Now, in addition, the drawings and application clearly illustrate and describe a machine which can be fed pre-split pears without making any change in the commercial machine. When so fed, the splitting knife, if left in, *would perform no splitting function*. Everything else in the machine would function exactly and precisely in the same manner, including the pear clamping member, the bobbing knife, the peeling knife, the coring knife, and the scavenger device which finally empties the cups. Of that there can be no question. That is all fully disclosed in the application and has been proven beyond question in this lawsuit. There is a full and complete disclosure in the drawings and specification of every element and feature covered by the subcombination claims. The cases cited in the department's brief on the matter of disclosure had to do with situations where it was attempted to inject claims directed to features or elements not illustrated or described. We have no such situation here. The pre-splitting of pears was notoriously old before this invention. The art well understood that, and as the Court of Appeals said (R. 148):

"The notion that the bobbing operation cannot take place after the pear has been split by hand ignores the texture and character of canning pears. The suggestion that the subcombination is inoperative when the pear is pre-split by hand is directly contrary to the evidence, particularly to the incontrovertible evidence of the motion picture which was displayed to this court as well as to the trial court. The notion that the inventor must have thought only in terms of splitting as an intermediate process, ignores the long history of pear canning as a hand process, and the inescapable fact that one who was experimenting in this area must have tried a variety of arrangements until he found the one most adapted to his purpose."

So far as the Ewald machine is concerned, whether you feed a whole pear or a pre-split pear, the operation is exactly the same for the attendant. The pear, after splitting, is of exactly the same contour as a whole pear. He could pick one up as easily as the other and place it in the first pear clamp at the feeding station. In the canning factories the pears are first incubated in a building, to a standard uniform yellow ripeness. Then when fed to the machine, as they come off the line, after the knife cleaves the pear, the flesh and juice of the pear are such as to cause the halves to adhere face to face. Indeed, as testified by Skog, after the pre-split pear is placed in the gripper means (R. 21), it is held *just the same as a whole pear and would stand the shock of the bobbing knife*, and the transfer mechanism takes it out of the gripper where initially placed and passes it on to the next station. He further testified (R. 22) that the transfer carriage is so designed that the line of cleavage between the two halves is in line with the front edge of the spreader blades so that as the two halves approach the front edge of the spreader wings, one half will go to one side of the spreader blades and the other half to the opposite side, exactly the same as though a whole pear had been fed in and the splitter knife used.

He further testified, on cross examination (R. 27), that after the pre-split pear was placed in the gripper means it went through the bobbing station into the transfer station and into the cups "*without being displaced at all.*"

Point XIII.

The department's brief, on page 8, admits that the claims in issue were first included by petitioner's assignor, *who was Mark Ewald himself*, which is a fact clearly shown by the record. This demonstrates that both parties are in full accord that the Court of Appeals was in error when

said in its opinion (R. 148) that these claims were filed the inventor's *assignee* seven years after the original application. They were filed by Ewald himself concurrently with Ewald's petition to reinstate the case, and they were presented in this litigation by Ewald as part of his original bill of complaint. Further, the present petitioner, Special Equipment Company, was Ewald's own company, which he was manager and president (R. 15).

On page 9 of the same brief, it is said that petitioner's witness testified that the use of the machine, minus the splitting knife, was a disadvantageous method. The facts are these: Skog, after testifying on cross-examination that he could not see there would be any advantage in pre-splitting, was asked this question: "But as compared with the machine (Ewald's) as it now stands, pre-splitting would be a disadvantageous method, would it not?" and answered: "Yes, sir, I will have to admit that."

It is thus quite clear that all he meant was that pre-splitting would be disadvantageous as compared with the use of the splitter in the machine. He testified (R. 25) that pre-splitting would make Ewald's machine "very practical commercially", even though they didn't use the splitting knife in the machine and that (R. 26) if they discontinued the use of the splitting knife in the Ewald machine, its advantages "are *so far ahead*" that the machine would still "justify itself very much." He further testified (R. 26):

"Q. Now, putting two halves of a pear in at one time, they would have to be very accurately positioned, would they not, in the machine?"

"A. Well, that could be taken care of very easily, if a hand splitter were used. She could split and place the pears in pockets that passed in front of the operator that fed the machine in this application; or if

they were automatically fed from a previous machine, then naturally the halves would be held right together all the time until placed in the first turret holders."

Moreover, the Appellate Court found from the evidence, and from Skog's testimony, and the motion picture exhibit, that, without the knife, the Ewald machine operated satisfactorily on pre-split pears, and was a tremendous advance over the prior art (R. 148). The evidence of Skog shows that when the machine was so operated without the knife on pre-split pears, the only change was to take out the knife. It is obvious that all the remaining parts would have to operate and function in precisely the same manner as when whole pears were fed, as shown by the record.

Point XIV.

Ewald fully complied with the statutes when he illustrated in his drawings and described in his specification his primary, basic, generic invention, and disclosed his *preferred* mode or method of using, which, in the particular preferred form shown, incorporated a splitting knife in the transfer line between the two turrets. It is evident from the elements and features he has shown that his machine could be operated on pre-split pears, as the evidence shows, and the Appellate Court found, that when so operated, the splitting knife would be useless and, therefore, could be omitted. The splitting knife, if used, need not necessarily be in the transfer line, but could be positioned in advance of the first turret or bobbing means, or the pears could be pre-split by hand, or by a separate machine. It seems quite clear, under the law, that Ewald is entitled to a claim which would cover his primary or main invention, regardless of which way it is used. (*Smith v. Snow*, 294 U. S. 1, 11.)

Point XV.

It is well settled in the Patent Office that in mechanical cases the disclosure of a given number of elements cooperating for a fixed purpose will support claims to a lesser number of the same elements, and that subcombinations of the disclosed structure may be claimed, whether or not they have independent utility and whether or not they were originally claimed. (*Ex parte Hedding*, 39 U.S.P.Q. 400; *Ex parte Gulliksen*, 46 U.S.P.Q. 429; *Ex parte Joy*, 51 U.S.P.Q. 339.) Therefore, the Board of Appeals in the present case ignored this long well established rule in the Patent Office.

Point XVI.

As to the new points which the Department seeks to raise here for the first time, the decisions seem to indicate that only those questions raised in the petition for the writ will be **considered**. *Crown Cork Co. v. Gutmann Co.*, 304 U. S. 159, 161; *General Pictures Co. v. Electric Co.*, 304 U. S. 175, 179; *Rorick v. Devon Syndicate*, 307 U. S. 299, 303.)

The decisions also indicate that in the event of a plain error, in special cases, an issue not specified in the petition might be considered. (*Kessler v. Strecker*, 307 U. S. 22.)

While this seems to be the rule, an examination of a large number of cases in this court shows that when issues are raised for the first time in this court, this court has refused to give them consideration.

Point XVII.

On page 38 of the department's brief, it says:

"It is equally well settled that findings such as those made here were ample to uphold rejection of the claims in question."

And cites a number of cases. A reading of those decisions demonstrates they have no application to the situation here.

CONCLUSION.

For the reasons set forth in our main brief and this reply, we contend, that the claims in issue should be allowed.

Respectfully submitted,

CLARENCE J. LOFTUS,
JAMES BALLARD MOORE,
CURTIS F. PRANGLEY,
JAMES M. GRAVES,
Counsel for Petitioner.

C.J.L.

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